



PATENT  
Attorney Docket No. 08048.0026-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Jean-Louis H. GUERET

Application No.: 10/084,975

Filed: March 1, 2002

For: BRUSH FOR APPLYING  
PRODUCT TO KERATINOUS  
FIBERS

)  
) Group Art Unit: 3732  
)  
) Examiner: Robyn Doan  
)  
) Confirmation No.: 2195  
)

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 1.193, Appellant submits this Reply Brief under  
37 C.F.R. § 41.41 to the Board of Patent Appeals and Interferences ("the Board"), from  
the August 4, 2006 Examiner's Answer in this case.

**Response to New Arguments Set Forth in the Examiner's Answer**

In the Examiner's Answer, the Examiner has set forth new arguments. For example, the Examiner has offered new arguments in an attempt to respond to Appellant's position that the Examiner has failed to show a reasonable expectation of success in attempting to combine the cited references. On page 19 of the Appeal Brief, Appellant argued that Ashtary does not "disclose or suggest that the brushlike elements are capable of applying mascara and curling the eyelashes when the elements are NOT brought together," and that, "therefore, there is nothing that would give one of ordinary skill a reasonable expectation that the brushlike elements of Ashtary would be successful at 'applying mascara and curling the eyelash[es],' when incorporated into the device of Gueret, which does not require a mechanism for bringing brushlike elements together."

In response, the Examiner alleges that because different curved shapes are purportedly known in the art of mascara brushes, "it would be obvious to one of ordinary skill in the art that the shape suggested by Ashtary would be successful in the brush of Gueret." Answer at 7. However, regardless of whether any particular shapes are shown in Ashtary and regardless of whether such shapes are combinable with Gueret, neither Ashtary nor Gueret provides any teaching or suggestion of a brush portion free end "not aligned with" a longitudinal axis of an end portion of a stem, as recited in claims 1, 43, 64, 80, and 96. Ashtary's mere mention of a scissor mechanism having brushlike elements that can be slightly arched concavely (col. 3, lines 61-64) does not provide any suggestion of the recited brush portion free end not aligned with a longitudinal axis of an end portion of a stem. As such, the applied references fail to

disclose or suggest all of the elements and limitations recited in claims 1, 43, 64, 80, and 96. Therefore, at least one of the requirements for establishing a *prima facie* case of obviousness is lacking with respect to these claims. For at least this reason, the section 103(a) rejection of claims 1, 43, 64, 80, and 96 should be reversed.

Moreover, notwithstanding the Examiner's unsupported conclusions, there is no disclosure or suggestion in the references or any other source that would have indicated, to one of ordinary skill in the art, that the configuration of Ashtary would have any reasonable expectation of being successful in the brush of Gueret. Because there is no reasonable expectation of success for this combination, at least one of the requirements for establishing a *prima facie* case of obviousness is lacking with respect to claims 1, 43, 64, 80, and 96. For at least this reason, the section 103(a) rejection of these claims should be reversed.

Additionally, the Examiner has now cited In re Rose, 105 U.S.P.Q. 237 (CCPA 1955) in an attempt to support her apparent allegation that reconfiguring Gueret in a manner corresponding to claims 14-16 and 55 would have been "within the level on [sic] ordinary skill in the art." Answer at 7. Contrary to the Examiner's allegation, however, In re Rose does not discuss shapes at all. Therefore, In re Rose fails to support the proposition for which it has been cited by the Examiner. Further, no *prima facie* case of obviousness has been established with respect to claims 14-16 and 55 because there is no motivation, suggestion, or teaching to change the configuration of Gueret in the manner suggested by the Examiner. For at least these reasons, the section 103(a) rejection of claims 14-16 and 55 should be reversed.

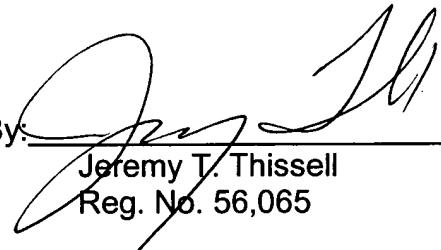
**Conclusion**

For the reasons presented in the Appeal Brief filed June 9, 2006, and the additional reasons outlined above, the Board is kindly requested to reverse the rejections of claims 1-12, 14-16, 20-27, 33-51, 55, 61, 62, 64-72, 75-88, 91-104, and 107-111.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
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Dated: October 4, 2006